

U.S. Patent Application Serial No. 10/807,174
Amendment filed October 29, 2007
Reply to OA dated June 4, 2007

REMARKS

Claims 1-7 are pending in this application. Claim 1 is amended herein. Upon entry of this amendment, claims 1-7 will be pending. Entry of this amendment and reconsideration of the rejections are respectfully requested.

No new matter has been introduced by this Amendment. Support for the amendments to the claims is discussed below.

It is suggested that the phrase "as well as" is preferably removed from claim 1 to be in compliance with US Patent practice. (Office Action paragraph no. 4)

The objection is overcome by the amendment to claim 1. The recitation "as well as a solvent" has been amended to --and a solvent--. This amendment represents a stylistic change only.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action paragraph no. 6)

The rejection is overcome by the clarifying amendment to claim 1.

Claim 1, line 3, has been amended "followed by vaporizing a predetermined amount of the alcohol produced by the reaction of the tetraalkoxysilane, an alkyltrialkoxysilane, and/or a trialcoxysilane" to clarify the recitation of "alcohol."

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Support for this amendment may be found in the specification on page 19, lines 8-12, where it states: "ethanol formed by the maturation was removed." This refers to the maturation (page 19, line 6) of the reaction of tetraethoxysilane and methyltriethoxysilane. That is, the "alcohol" in claim 1 is the alkyl alcohol resulting from the reaction of the tetralkoxysilane, alkyltrialkoxysilane and/or trialkoxysilane components of the mixture.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakata et al. (US 6,613,834) or Nakata et al. (US 6,958,525) or Nakata et al. (US 2006/022357). (Office Action paragraph no. 8)

The rejection is overcome by the attached Declaration under 37 CFR 1.132 in accordance with MPEP 715.01(a), in which the present inventors declare that they conceived or invented the subject matter disclosed in the references and cited in the rejection. The Examiner noted in the rejection that such a Declaration might be appropriate for overcoming the rejection.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-127152 in view of Rutherford et al. (US 6,318,124). (Office Action paragraph no. 10)

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-127152 in view of Rutherford et al. (US 6,318,124) as applied to claim 1 above, further in view of JP 64-009231. (Office Action paragraph no. 11)

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These rejections are overcome by the assertion of the claim for foreign priority in this application.

Reference JP2001-127152 was published on May 11, 2001. The present application claims foreign priority of JP 2001-84475, filed March 23, 2001. Applicant has attached a verified translation of the priority document, and Applicant submits that the present claims are fully supported by the priority document.

JP2001-127152 is therefore removed as prior art. Applicant submits that the pending claims are not obvious over Rutherford et al. (US 6,318,124) and JP 64-009231, taken separately or in combination.

Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,958,525. (Office Action paragraph no. 13)

Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,727,515. (Office Action paragraph no. 14)

Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, 18 and 19 of copending Application No. 11/205,128. (Office Action paragraph no. 15)

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These rejections are obviated by the filing of terminal disclaimers over the respective patents and copending application. The Terminal Disclaimer papers are filed concurrently with the present Response.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosures: Terminal Disclaimers (3)
RCE Transmittal
Petition for Extension of Time
Declaration under 1.132
Verified translation of JP 2001-084475

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